

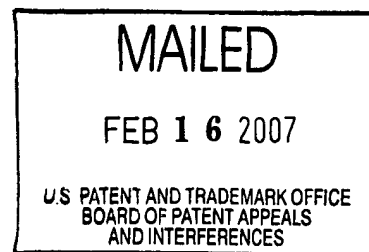
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR I DEONARINE,

Appeal 2006-3282
Application 09/683,353
Technology Center 2800



Decided: February 16, 2007

Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT, and JAY P. LUCAS, Administrative Patent Judges.

LUCAS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. 134 from the Final Rejection of Application No. 09/683353. A copy of the claims under appeal was submitted on July 26, 2006. Appellant's brief was filed February 27, 2004; Appellant Supplemental Brief was filed September 22, 2004 and Appellant's Reply Brief was filed May 17, 2005. The Examiner mailed his Answer on April 15, 2005.

INVENTION

Appellant's invention relates to an apparatus for indicating the temperature of a material, useful in welding. The invention includes a connector for holding a pair of temperature indicator sticks, where each indicator stick melts at a different temperature. These indicator sticks are rated to measure a given temperature, which is generally not the same value, during welding, heat treatment, and metal fabrication processes. The connector is further configured to removably hold the indicator sticks together, and includes a convenient pocket clip.

Claims 1 and 16 are representative of the claimed invention and are reproduced as follows:

1. A dual temperature indicator stick assembly comprising:

a first indicator stick housing positioned along a first axis and configured to hold a compound which melts at a first given temperature;

a second indicator stick housing positioned along a second axis and configured to hold a second compound which melts at a second given temperature; and

a one-piece connector physically connecting the first and second indicator stick housings along different axes.

16. A dual temperature indicator stick apparatus comprising:

first means for indicating a first temperature;

second means for indicating a second temperature; and

means for retaining the first means to the second means in a side-by-side relationship to form an indicator stick assembly capable of indicating at least two temperatures.

REFERENCES

The references relied on by the Examiner are as follows:

Peterson	US 1,603,713	Oct. 19, 1926
Kirk	US 3,564,668	Feb. 23, 1971
Aronson	US 4,244,660	Jan. 13, 1981
Kossnar	US 6,022,159	Feb. 20, 2000
Omega [®] Engineering Inc., "The Temperature Handbook", Vol. 29, pg. F10 (Omegamarker [®] Temperature Test Kit), 1995 (OMEGA [®])		

REJECTIONS AT ISSUE

Claims 1, 6, 8, 16 and 18 to 20 stand rejected under 35 U.S.C. § 102b as being anticipated by OMEGA[®].

Claims 1, 3, and 6 stand rejected under 35 U.S.C. § 102b as being anticipated by Kossnar.

Claims 1, 3, 5, 6, 8, and 9 stand rejected under 35 U.S.C. § 102b as being anticipated by Kirk.

Claims 1, 3, 5, 6, and 8 stand rejected under 35 U.S.C. § 102b as being anticipated by Aaronson.

Claim 17 stands rejected under 35 U.S.C. § 103a as being obvious over the combination of OMEGA[®] in view of Peterson.

The rejection of claims 2, 4, 7, and 10 to 15 has been withdrawn.

ISSUES

The Examiner contends that the OMEGA[®], Kossnar, Kirk and Aaronson references demonstrate that the various claims, as indicated in the

rejections itemized above, are anticipated by or rendered obvious over the prior art.

The Appellant respectfully disagrees, and argues that the Examiner has misread the teachings of the art and mistakenly applied them to the claimed subject matter.

The issue before us is whether the Examiner erred in rejecting the claims over the references as applied above.

PRINCIPLES OF LAW

This application presents questions of anticipation and obviousness.

In examination before the USPTO, the Examiner bears the burden of presenting a *prima facie* case for the obviousness,[or anticipation,] of the claimed subject matter. *See In re Rinehart*, 531 F2d 1048, 189 USPQ 143 (CCPA 1976).

The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact. *In re Dembiczak*, 175 F.3d 994, 998 [50 USPQ2d 1614] (Fed. Cir. 1999).

FINDINGS OF FACT

We find the following facts:

1. Pursuant to 35 U.S.C. 102, Examiner has read the elements of claims 1, 6, 8, 16 and 18 to 20 on the reference OMEGA[®]. Appellant argues that the claims 1 and 16 call for a dual temperature indicator stick assembly and apparatus, and the OMEGA[®] reference shows a series of temperature indicator sticks in a case. Although the weight to be accorded to the

terms in the preamble has been argued, we find that the OMEGA[®] reference does disclose an assembly or apparatus of multiple temperature indicator sticks that comprises the recited elements. Appellant argues that the use of the markers in the reference requires them to be removed from the case, thus obviating the reference. Such argument reads a non-existent use limitation into the preamble term, which cannot be given weight. (*See In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed Cir 1994). The three elements of claim 1, the two housings and the connector, are clearly demonstrated in OMEGA[®]. Also disclosed in OMEGA[®] is the connector's snap fit of the indicator stick housings as recited in claim 8, as the term is generally understood. No special definition of "snap fit" is found in the specification. (*See In re Phillips*, 75 USPQ2d 1321 (Fed Cir 2005)). We further find the temperature indicator sticks as recited in claim 18, and the tubular members secured by a connector of claim 19, as indicated by the Examiner. We do not find the elements of claims 6 and 20 in OMEGA[®].

2. The examiner has read the elements of claims 1, 3 and 6 on the pen holder of Kossnar. As the Kossnar reference does not mention temperature indicator sticks, the issue of the weight to be given to the terms "dual temperature indicator stick assembly" in the preamble, and "configured to hold a compound that melts ..." in the elements comes clearly to the

forefront. Considering the latter phrase first, we consider whether “configured to hold a compound...” is a “...mere direction of activities to take place in the future, or whether the language imparts a structural limitation ...” to the stick housing. (*See In re Venezia*, 189 USPQ 149, 151 (CCPA 1976)). We find that the language does impart structure to the housing, namely sufficient structure to hold something. The claim, however, does not recite the thing that is held, namely a “compound which melts...” as an element of the claim. (Appose this to claim 2, which does positively recite indicator sticks, and has not been rejected.) The elements of the claim thus include two housings, each positioned specially and configured to hold something. Consider, now, the preamble which recites “A dual temperature indicator stick assembly comprising...” The Kossnar reference discloses a dual pen holder, with elements corresponding to all of the claimed elements in claims 1, 3 and 6, as applied by the Examiner. We find the recitation in the claim preamble of “A dual temperature indicator stick assembly comprising ...” to be merely a statement of the purpose and intended use of the assembly. The assembly recited in the structure of the claims is found in Kossnar, albeit holding a different type of writing utensil. Specifically we find in Kossnar a teaching of longitudinal member 20a (and 20b) with curved ends (at 46) to hold the housings of the writing utensils. This teaching is also

applicable to claim 20, which claims the curved ends integrally molded to each of the tubular members. We find the teaching includes the writing utensils being “slidingly secured” in a side-by-side relationship.

3. Examiner has further rejected claims 1, 3, 5, 6, 8, and 9 as being anticipated by Kirk. We find that Kirk presents the claimed elements, when viewed consistently with the findings above in #2. Kirk teaches a holder for pens, pencil and the like, which the Examiner has chosen as another prior art teaching of the claimed assembly. As the Examiner explains, element 10 can be read as a clip member, configured with the structure as recited in the claims.
4. Examiner has further, as expressed by Appellant, duplicatively rejected claims 1, 3, 5, 6 and 8 as being anticipated by Aaronson. Viewing Aaronson’s Figure 1 and the supporting text in the patent we indeed find that the claimed elements are present in that reference. The arguments expressed in Finding #2 above are applied to the interpretation of the claims.
5. Examiner has rejected claim 17 for being obvious over the combination of OMEGA[®] in view of Peterson. Examiner proposes that OMEGA[®] teaches all of the claimed elements of claim 17, except for means for controlling movement of the “first and second” means. Peterson teaches a mechanism for controlling such movement, in a casing we find to be similar to that claimed by the Appellant. The holder of Peterson is for a

marking crayon used in industry. We find that one skilled in the art at the time of the invention who would search for a means for controlling movement of the temperature indicating means of OMEGA[®] would look to the old teaching of Peterson and combine them. Thus we find that the elements of claim 17 would be obvious over the cited references.

ANALYSIS

The elements of claims 1, 3, 5, 6, 8, 9, 16 and 20 are present in the prior art, as demonstrated by the references OMEGA[®], Kossnar, Kirk and Aronson, in a manner to anticipate the claims as presented.

Claim 17 is rendered obvious over the prior art OMEGA[®] in view of Peterson.

NEW GROUND OF REJECTION

The following new rejection of claim 20 is entered under the provisions of 37 CFR § 41.50 (b).

Claim 20 is rejected under 35 U.S.C. § 102 (b) for being anticipated by Kossnar. Figure 2 of Kossnar indicates elements 20a and 20b which are longitudinal members with curved ends integrally molded therein, as claimed.

OTHER ISSUES

Examiner is reminded that USPTO procedures require that rejections be fully repeated in the Examiner's Answer, and that the Board not be referenced to other actions (e.g. Final Rejections) in the file. See MPEP 1207.02. In the interest of reasonable dispatch of this appeal the procedure

was overlooked; however in future appeals an administrative remand would be appropriate.

CONCLUSIONS OF LAW

In view of the foregoing discussion, we sustain the Examiner's rejection under 35 U.S.C. § 102(b) of claims 1, 3, 5, 6, 8, 9, 16, and 18 to 19 under the various references as itemized above. We have sustained the rejection under 35 U.S.C. §103(a) of claim 17.

The Examiner's rejection of claim 20 is reversed.

We have entered a new ground of rejection for claim 20.

ORDER

The rejections are AFFIRMED in PART as indicated above.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART

PGC/GW

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